

***REMARKS***

No amendments, additions or cancellations to the claims have been made herein. Thus, a listing of the claims is not needed.

***Status of the Claims***

Claims 1, 7, 8, 13-20 and 27-34 are pending in the present application. Also, claims 1, 13-15, 17-20, 29 and 34 are indicated to be allowable.

However, claims 7, 8, 16, 27, 28 and 30-33 are rejected. Applicants respectfully submit the following remarks with regard to the rejection of these claims. Overall, it is believed that all rejections have been overcome.

***Issues Under 35 U.S.C. § 112, Second Paragraph***

Claims 16 and 31-33 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite (as stated at the top of page 2 of the Office Action). This rejection is respectfully traversed, and reconsideration and withdrawal thereof are respectfully requested.

The Examiner is concerned as to whether the claimed glycoside is the sugar or sugar alcohol. However, Applicants respectfully submit that a glycoside is not the recited sugar or the sugar alcohol. In this regard, Applicants respectfully refer the Examiner to lines 7-8 of pending claim 1 that recites the glycoside linkage that binds to, and thus is separate from, either the sugar or sugar alcohol (see the Reply of March 25, 2005, page 2).

Further, Applicants herein attach excerpts of two references: (a) "Textbook of Organic Chemistry", Louis F. Fieser and Mary Fieser (see pages 333-335); and (b) "The Carbohydrates - Chemistry and Biochemistry", W.G. Overhend (see pages 279-280). As can be seen from the attached excerpts, the instantly claimed glycosidic linkage merely refers to the type of linkage between the hydrophobic group and the sugar or sugar alcohol (see, e.g., page 280, lines 16+ and 23+ of the Overhend excerpt). Further, as can be seen from lines 7-8 of pending claim 1, the recited glycoside linkage refers to the binding to the sugar or sugar alcohol. Thus, it is respectfully submitted that one of skill in the art would understand what is instantly claimed in claims 16 and 31.

With regard to claims 32 and 33, these claims refer to an ester linkage. Thus, it is believed that this rejection is moot.

Therefore, Applicants respectfully submit that claims 16 and 31-33 fully comply with the provisions of 35 U.S.C. § 112, second paragraph. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

***Issues Under 35 U.S.C. § 103(a)***

Claims 7, 8, 27, 28 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McArdle (U.S. Patent No. 5,747,416; hereinafter "McArdle '416") and Brantley (U.S. Patent No. 3,929,448; hereinafter "Brantley '448") (both references are newly cited). This rejection is respectfully traversed. Reconsideration and withdrawal thereof are respectfully requested as follows.

The cited primary reference of McArdle '416 discloses, e.g., a protein-polysaccharide complex with usage for cut flowers, etc. (see Abstract; Col. 1, lines 5-36; see also Col. 3, lines 5+). Also, the other cited secondary reference of Brantley '448 discloses, e.g., a composition used to preserve cut flowers (see Abstract; claims 1 and 7 at Cols. 5-6). However, Applicants do not concede that a *prima facie* case of obviousness has been established, and Applicants respectfully traverse the Examiner's reasoning for combining the two references (as stated in the Office Action at page 3, lines 1-5).

In particular, the Examiner states it would be obvious to obtain "a single composition comprising protein-polysaccharide and sugar" based on the references' disclosure. However, not all features of the present invention are accounted for in the Office Action. Specifically, the protein-polysaccharide of McArdle '416 is not a surfactant as instantly claimed. Applicants respectfully refer to columns 3 and 4 of McArdle '416, which shows a protein-polysaccharide used together with a surfactant. This disclosure in McArdle '416 thus indicates that the referenced protein-polysaccharide is not a surfactant, and that the McArdle '416 protein-polysaccharide is structurally different from the claimed surfactant. Accordingly, combining the protein-polysaccharide of McArdle '416 with the sugar of Brantley '448 does not give the present invention. Applicants note that a *prima facie* case of obviousness requires disclosure of all claimed features in the Office Action. See *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); see also *In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000); *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).

Further, Applicants submit that the requisite reasonable expectation is lacking as well. Again based on the Examiner's reasoning for combining the two references (as stated in the Office Action at page 3, lines 1-5), any two or more patents or references merely disclosing a composition (with any ingredients) can be combined until the present invention is eventually received. In other words, the Examiner is using an improper "obvious to try" rationale. Applicants note that: "Obviousness requires one of ordinary skill in the art have a reasonable expectation of success as to the invention—'obvious to try' and 'absolute predictability' are incorrect standards." *Velandier v. Garner*, 68, USPQ2d 1769, 1784 (Fed. Cir. 2003) (citing *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673 (Fed. Cir. 1988)). Thus, the requisite reasonable expectation of success is lacking based on the "obvious to try" rationale to combine the two cited references.

Along the same lines, Applicants also submit that the requisite motivation is lacking. This is because the mere fact that disclosures can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination. *See, In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984) and *In re Imperato*, 179 USPQ 730, 732 (CCPA 1973). There is no suggestion here, other than the noted "obvious to try" rationale being employed.

Applicants also submit that one of ordinary skill in the art would understand that McArdle '416 is directed to controlling insect infestation and growth of weeds (see, e.g., the Abstract; column 2, lines 18-67), which is different from what is instantly claimed. Thus, the requisite motivation is lacking since any cited reference used for a rejection under 35 U.S.C. §

103(a) must be considered in its entirety, *i.e.*, as a whole, including those portions that would lead away from a claimed invention. *See W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Finally, Applicants submit that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. *See* M.P.E.P. §§ 2143.01, 2145(III). In this regard, the Examiner states it would be obvious to obtain “a single composition comprising protein-polysaccharide and sugar” based on the references’ disclosure. However, the protein-polysaccharide is not a surfactant as claimed. Thus, the protein-polysaccharide of McArdle ‘416 would have to be taken away for one of ordinary skill in the art to make the present invention. However, such a proposal to achieve what is instantly claimed cannot change the principle of operation of the primary reference (McArdle ‘416) or render the reference inoperable for its intended purpose. Thus, the requisite motivation is lacking for this additional reason.

Accordingly, Applicants respectfully submit that the instant rejection under 35 U.S.C. § 103(a) has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

***Allowable Subject Matter***

Claims 1, 13-15, 17-20, 29 and 34 are indicated to be allowable. However, Applicants also request favorable consideration of the other pending claims, as it is believed that all

outstanding rejections have been overcome. Applicants also request favorable consideration of pending claim 8, since this claim depends on already allowed claim 1.

***Conclusion***

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact Eugene T. Perez (Reg. No. 48,501) at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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**Attachments:**

- Pages 332-335 of "Textbook of Organic Chemistry", Fieser et al. (1952)
- Pages 279-281 of "The Carbohydrates - Chemistry and Biochemistry", W.G. Overend (Second Ed.)